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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,473	11/29/2000	Kenneth Curry	24406	5303

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,473

Applicant(s)

CURRY ET AL.

Examiner

Rebecca L Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,8-12 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 1,3,5-7 and 13-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-21 are currently pending in the instant application. Claims 2, 4, 8-12 and 18-21 are withdrawn as being to a non-elected invention. Claims 1, 3, 5-7 and 13-17 are objected to as containing non-elected subject matter. Claims 14 and 15 are rejected.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-4, 6 and 11-13 in Paper No. 17 is acknowledged. The traversal is on the ground(s) that under 37 CFR 1.475 (b) (3) that a national stage application will be considered to have unity of invention if the claims are drawn only to the combination of "A product, a process specially adapted for the manufacture of the said product, and a use of the said product," and Groups I, III and IV are drawn to this combination. The traversal is also on the grounds that an appropriate explanation as to the existence of a serious burden is omitted (MPEP 803). These traversals are not found persuasive because under 37 CFR 1.475 (a), the requirement of unity of invention will only be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features, which are those technical features that define a contribution, which each of the claimed inventions, considered as a whole, makes over the prior art, i.e. "where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." As mentioned in the lack of unity

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requirement of Paper No. 15, the claims at issue (claims 1-7 and 11-17) herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The technical feature which corresponds to claims 1-7 and 11-17 is cubane, which does not define a contribution over the prior art. The substituents on the cubane derivative vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, in regards to the traversal on the omitted explanation as to the existence of a serious burden, it is noted that burden is not a requirement for a holding of lack of unity and the argument is considered moot. Section 803 of the MPEP is found in Chapter 800 which is restriction in applications filed under 35 U.S.C. 111. However, this is not the case in the instant application, which is a National Stage entry under 35 U.S.C. 371. The discussion of unity of invention under the Patent Cooperation Treaty Articles and Rules as it is applied as an in applications entering the National Stage under 35 U.S.C. 371 as a Designated or Elected Office in the U.S. Patent and Trademark Office is covered in Chapter 1800. Finally, in regards to the traversal of the duplicate filing fees, it is noted that this is also not a requirement for a holding of lack of unity and the argument is considered moot.

The requirement is still deemed proper, however, the examiner will search and examine Groups I, III and IV (claims 1-4, 6, 11-13, 5, 7 and 14-17) drawn to products of the formula I, wherein R1 is carboxyl, R2 is 1-3 amino, R3 is -CH₂-thioxanthyl and R4

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is carboxyl, methods of modulating metabotropic glutamate receptor with the compound of the formula I, wherein R1 is carboxyl, R2 is 1-3 amino, R3 is -CH₂-thioxanthyl and R4 is carboxyl and processes for preparing compounds of formula I wherein R1 is carboxyl, R2 is 1-3 amino, R3 is -CH₂-thioxanthyl and R4 is carboxyl as per page 4 of applicant's response filed 2 December 2002. The remaining subject matter of claims 1, 3, 5-7 and 13-17 and the subject matter of claims 2, 4, 8-12 and 18-21 stands withdrawn as being for non-elected inventions. The withdrawn subject matter of the claims is properly restricted as said subject matter differs materially in structure and element from the elected subject matter so as to be patentably distinct, i.e. a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Additionally, the fields of search are not co-extensive.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "anxiety and related disorders" on line 6 of claim 14 and lines 6-7 of claim 15 on page 5 of Paper No. 17 renders the claims indefinite because it is unclear what disorders are "related" to anxiety. Page 17 of the instant specification provides no direction as to what disorders would be considered "related" to anxiety. This rejection can be overcome by deleting "and related" from both of the claims.

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Regarding claims 14 and 15 the phrases "(i.e. opiates, benzodiazepines, nicotine, cocaine, or ethanol" (claim 14, page 5 of Paper No. 17, lines 4-5) and "e.g. panic attack" (claim 14, page 5 of Paper No. 17, line 6 and claim 15, page 5 of Paper No. 17, line 7) renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). This rejection can be overcome by deleting the phrases "(i.e. opiates, benzodiazepines, nicotine, cocaine, or ethanol" and "e.g. panic attack" from claim 14 and by deleting the phrase "e.g. panic attack" from claim 15

Claim Objections

Claims 1, 3, 5-7 and 13-17 are objected to as containing non-elected subject matter. The claims presented drawn solely to the elected subject matter as indicated above and on lines 1-10 of page 4 of applicants response filed 2 December 2002 and free of the 112 rejections mentioned supra would appear allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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